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EXAMINER				
WALLS, DIONNE A				
ART UNIT		PAPER NUMBER		
9731				

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/031,875

Applicant(s)

FOURNIER ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory maximum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet, 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet, 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1- 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,289,898. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims containing recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. in "an electrical smoking system") does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (see MPEP 2114 – which applies equally to "article" claims).

Note: Applicants have indicated, in the Amendment filed on November 7<sup>th</sup>, 2003, that a Terminal Disclaimer would be submitted "in due course".

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,3, 5-6, 14, 18, 21, 24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarty et al (US. Pat. No. 3,744,496).

McCarty et al discloses all that is recited in the claims (see entire document, specifically col. 2, lines 9-55, col. 4, lines 28-29; table 4; see abstract. Note: Claims containing recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. "in the electrical smoking system") does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (see MPEP 2114 – which applies equally to "article" claims). Therefore, this requirement, in the instant claims, reciting that the product is for use in "an electrical smoking system" would have been inherent in the wrapper of McCarty et al since said wrapper can be wrapped around a cigarette, which is then capable of being used in such a system.)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al (US. Pat. No. 3,744,496).

Regarding claims 7-8, in the examples of McCarty et al, the wrapper of its invention has a basis weights of around 60 g/m<sup>2</sup>. McCarty also discloses that the porosity of its wrapper can be tailored to fit the requirements of the finished cigarette (see cols. 3-4). While McCarty may not explicitly disclose, exactly, the claimed basis weight and porosity parameter combinations, it would have been obvious to one having ordinary skill in the art at the time of the invention to discover these parameters, after minimal experimentation, in order to arrive at a wrapper having optimal burn characteristics.

Regarding claims 9-11, McCarty et al may discloses that (while not required) burn additives, such as alkali metal carbonates, can be utilized. And while the salts listed in claim 11 may not specifically be articulated, McCarty does state that citrates, phosphates or nitrates can be used. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize one of the alkali metal salts claimed since these are few of several well known burn promoters in the tobacco art.

Regarding claim 19, while McCarty et al may not disclose that the gaseous component whose content is reduced by the presence of the filler during combustion of the smoking article includes at least aldehyde, McCarty et al does suggest that major organic vapor phase yield is greatly reduced (col. 4, lines 56-64). This would suggest to one of ordinary skill in the art that aldehyde, which is an organic vapor phase

component, is also reduced (at least to some extent) due to the presence of the particular filler material in the cigarette wrapper of McCarty.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al (US. Pat. No. 3,744,496) in view of Baldwin et al (US. Pat. No. 5,263,500).

While McCarty et al may not disclose the wrapper being perforated, it does state that the porosity of the wrapper may be tailored to fit the requirements of the finished cigarette, such as the air dilution of the smoke desired. Further, Baldwin et al states, in its "Background of the Invention", that the relationship of paper porosity to cigarette performance is well known. Specifically, if paper porosity is increased via perforations of the paper, then puff count increases and tar per puff decreases due to air dilution (see col. 1, lines 20-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to perforate the wrapper of McCarty et al in order to allow sufficient air to the fuel source so as to sustain combustion, while at the same time decreasing tar inhaled, per puff.

#### ***Allowable Subject Matter***

7. Claim 26 would be allowed, upon the filing of a Terminal Disclaimer.
8. Claims 2, 4, 12-13, 15-17, 22-23, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if a Terminal Disclaimer is filed.

***Response to Arguments***

9. Applicant's arguments filed on November 7<sup>th</sup>, 2003 have been fully considered but they are not persuasive.

- Applicants argue that the phrase "of an electrical system" patentably distinguishes the claimed wrapper and cigarettes from the wrapper and cigarettes disclosed in McCarty. The Examiner, however, disagrees, and believes that this phrase does not patentably define the claims over the reference since, structurally, the wrapper/cigarette of McCarty, in combination with the other references, is almost identical to that of the claimed wrapper. The wrapper/cigarette of McCarty has the same filler, burn additive, cellulosic, and tobacco web materials (Note: McCarty discloses that a tobacco materials can serve as the fiber pulp for the wrapper) of the instant invention. Further, Applicant has not provided evidence of why the claimed wrapper/cigarette has structural characteristics that are patentably distinguishable from that of the wrapper/cigarette disclosed in McCarty which would render it capable of being used in an electrical smoking system, and/or capable of reducing the content of gaseous/aldehyde components in the smoke, whereas the wrapper/cigarette of McCarty would be incapable of doing so. Until such evidence is provided, the Examiner will not be persuaded by Applicant's arguments.

***Conclusion***


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

  
Dionne A. Walls  
Primary Examiner  
Art Unit 1731

January 15, 2004